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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:) Attorney Docket No.: F-399
Ronald P. Sansone et al.) Group Art Unit: 3627
Serial No.: 10/033,224) Examiner: Gerald J. O'connor
Filed: October 26, 2001) Date: January 11, 2006
Title: **A METHOD AND SYSTEM FOR RETURNING A NON-SCALE BASED
PARCEL WEIGHT**

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION UNDER 37 CFR 41.37)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Corrected Appeal Brief filed on December 20, 2005.

Pursuant to 37 CFR 1.17(b), the fee for filing for the Appeal Brief has already been paid on March 8, 2002.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

A duplicate copy of this transmittal is enclosed for use in charging the Deposit Account.

Respectfully submitted,

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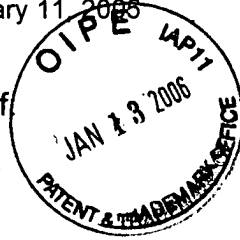
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Application No. 10/033,224
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In re patent application of
Ronald P. Sansone et al.

Serial No.: 10/033,224

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BASED PARCEL WEIGHT**

) Attorney Docket No.: F-399

) Group Art Unit: 3627

) Examiner: Gerald J. O'Connor

) Date: January 11, 2005

CORRECTED APPELLANT'S BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case August 17, 2005 and the December 20, 2005, Notification of Non-Compliant Appeal Brief.

This brief is transmitted in triplicate.

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I. REAL PARTY IN INTEREST

Pitney Bowes Inc. is the real party in interest by way of assignment from the Appellant.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

- A) Claims 3 - 17 are in the application.
- B) Claims 3 - 17 are rejected.
- C) Claims 1, 2, and 4 are cancelled
- D) Claims 3 and 5 - 17 are on appeal.

IV. STATUS OF AMENDMENTS

An Amendment is being filed herewith canceling claim 4. The Examiner indicated in a January 10, 2006 telephone conversation that claim 4 would be cancelled.

V. SUMMARY OF INVENTION

A. Background

The prior art does disclose a non-scale-based weight for use as an input in a shipping application that transmits a query from a routine to a database for a weight associated with a corresponding article, packing material, and a container; returning the weight to the routine; and displaying the cost to ship the article, packing material and container.

The technology afforded by faster and more memory-laden personal computer (PC) based data processing systems has allowed more and more functionality to get to the desktop. Desktop computing, followed by desktop publishing were among the first applications to reap the benefits of increased desktop capabilities. At present, the advances in the development of memory devices, such as hard disk drives, have allowed greater access to routine-intensive software that allows desktop users to produce work product that was being handled by mid-frame computers in the recent past.

The extensive development and advances that have guided the growth of the personal computer and its related systems has run a parallel course over the past decade with the explosive growth of the Internet. Systems that can utilize the Internet effectively provide their users with greater desktop power by accessing data that was previously unavailable or available only through traditional research vehicles. Thus, personal computing power has grown explosively.

As personal computing power has grown, so to has the variety of business related applications that have come to the desktop. Desktop publishing has allowed quality brochures to be produced in-house rather than at a commercial print shop. The Internet has allowed engineers to interactively participate in

projects and research, despite the separation of miles; and, activities such as mail piece production and parcel shipping, have found their way to the desktop as well.

Mail piece production, in the business environment, has traditionally been a product of several departments. Accounting produces a billing that is stuffed into envelopes; the envelopes are weighed as they are fed to a postage meter; and, a postage meter prints postage to the individual envelopes as a function of the weight and postal rate tables. This basic sequence is still the way that businesses produce billings on a month-to-month basis. However, the steps between printing of the mail piece contents, stuffing of the envelopes, weighing, and printing of a postage indicia have become quicker, more streamlined, and more accessible.

Parcel shipping, though following a different sequence of steps than mail piece production, also has benefited from desktop production efficiencies. Labels can be printed at the desktop, weighing scales are interconnected to PCs for inputting weight to a parcel shipping application, and manifests for recording the details of parcel pickup and delivery are printed at the desktop as well. Peripherals such as scanners and other input devices can also be added for increased data delivery.

Mailing and shipping applications still rely on an important piece of data in determining the cost of shipment; that piece of data is weight. Programs have been developed that print postage to an envelope at the desktop, but these programs still require a weighing device to input that parameter into an algorithm that will determine the proper postage rate to be applied when producing a postage indicia. An exception to a weight-based need is when the postage is set at a constant value and the weight of the mail piece is estimated; this exception is particularly susceptible to human error because of the estimation involved. Parcel shipping, in particular, is tied to the weight parameter in determining a

cost for shipping a parcel because of the profusion of services available from individual carriers and the fact that parcels tend to be of varied weight and size.

Some developed technology has attempted to eliminate the need for utilizing a weighing scale for inputting the weight parameter in determining postage charges. One such method and system has been disclosed in U.S. Patent No. 5,983,209 for a SYSTEM AND METHOD FOR DETERMINATION OF POSTAL ITEM WEIGHT BY CONTEXT issued November 9, 1999 to Salim G. Kara (hereinafter referred to as **Kara**). In **Kara**, parameters are input into the system that are associated with the context in which the mail piece is generated; the parameters can be manually input or can be input by the application which is generating the associated mail piece.

One drawback to **Kara** is the flexibility of the disclosed system. **Kara** is specifically drawn to "postal items" and thus does not address the issues associated with carrier management systems that require more varied input in addition to performing rate shopping among multiple carriers. **Kara**, though providing access to a resident database for determining component weights in calculating postage values does not provide a means of accessing non-resident databases; nor does Kara provide a means for training its resident database so as to provide a greater range of rating variables.

Another example of parameter-based charging for mail piece production is disclosed in U.S. Patent No. 5,873,073 for a METHOD AND SYSTEM FOR MAIL PIECE PRODUCTION UTILIZING A DATA CENTER AND INTER-RELATED COMMUNICATION NETWORKS issued February 16, 1999 to Bresnan et al. (hereinafter referred to as **Bresnan**). **Bresnan** discloses a method for producing finished mail pieces wherein the characteristics of the mail piece are input at a first node and the individual mail pieces are produced at a second or subsequent nodes. A cost is associated with each parameter that defines production of the mail piece and a total cost for the production is calculated.

Bresnan provides for building a final cost, akin to the postal value as determined by **Kara**, but does not address the issue of bringing the full parcel shipping application to the desktop; rather, **Bresnan** serves as a means of remote production.

B. APPELLANT'S CLAIMED INVENTION

Appellants claim a method that utilizes a non-scale-based weight as an input in a shipping application that transmits a query from a routine to a database for a weight associated with a corresponding article, packing material, and a container; returning the weight to the routine; and displaying the cost to ship the article, packing material and container.

The disadvantages of the prior art are overcome by a method and system for non-scale-based weight for use as an input in a shipping application.

The method provides for weight-based determinations of one or more articles to be shipped and comprises a number of steps. These steps begin with the initiation of a rate determining routine in a shipping system application resident in a processor-based data processing system located at a first at a first node. The initiation of the routine can be via Internet or modem. After initiation, a description of each one of the one or more articles is entered into a first data field of the rate determining routine. A query is then transmitted from the routine to a database located at a second node for a weight associated with each of the one or more articles; and, thus the initiating site can be remote to the database or co-located with it.

The database is for storing a set of one or more weights wherein each of the one or more weights is associated with a particular article. The database itself further comprises a set of Universal Product Code (UPC) data which comprises a Universal Product Code (UPC) database which associates a known article with a set of one or more of the article's characteristics and entry fields for

supplementing the data to the UPC database. Additionally, the database contains a set of data comprising a recorded weight associated with a set of one or more articles wherein the recorded weight is entered by a system operator.

Once the weight has been obtained, the weight is returned to the routine for use in calculating a rate for shipping one or more articles to a particular destination. The returned weight is entered into a second data field of the shipping system application as an input parameter; and, the rate for shipping each of the one or more articles to its particular destination is determined as based upon the input parameters. The input parameters may include a destination for the article, a class of service, or a delivery date.

Supplementation of the entry fields of the database comprises the steps of comparing data entered into the first data field with data resident in the database; determining whether or not the comparison further determines that the weight is available; and, if the weight is available, then returning the weight to the routine; or if the weight is not available, then querying the routine to determine whether or not a new weight is to be entered into the database by entry through the routine.

The new weight can be determined by one of several alternative entry means wherein the new weight is recorded in the entry fields of the database. The alternative entry can be made via a keyboard entry where the new weight is entered by a system operator; or, can be made via a data capture device such as a scanner or a weighing scale. Additionally, the new weight can be determined by calculating the new weight based upon a set of criteria to be applied to the database and to the first data field, and wherein the new weight is recorded in the entry fields of the database.

The system of the present disclosure comprises a number of elements; these include a data processing system located at a first node. The data processing system further includes a shipping system application having rate

determining means for determining a carrier rate to be charged for the shipping of an article via a carrier. The rate determining means includes a rate determining routine having a rates database and access means for accessing a rate determining function of a particular carrier. The rate determining function is accessible via an Internet entry or simply by calling the function from within the system.

The system additionally includes: data entry means for entering a description of the article to be shipped into a first data field of the shipping system application; transmission means for transmitting a query, for a weight associated with the article, from the shipping system application to a database located at a second node and then returning the weight to the application for use by the rate determining means; and, data entry means for entering the weight into a second data field of the shipping system application as an input parameter. The set of input parameters may include a destination for the article, a class of service, or a delivery date. The system further includes calculating means within the rate determining means for calculating the rate for shipping the article to a particular destination as based upon the set of one or more input parameters.

Claim 3 is one of the two independent claims in this patent application that is on appeal. Claim 3 is a method for returning a weight from a weight field of a database that has at least one data field for storing a set of data relative to a corresponding article, packing material, and container. Claim 3 includes the following steps: (a) initiating a cost determining routine in a shipping system application at a first node; (b) entering a description of said corresponding article, said packing material, and said container into a first data field of said rate determining routine; (c) transmitting a query from said routine to said database for a weight associated with said corresponding article, said packing material, and said container; (d) returning said weight to said routine; and (e) displaying the cost to ship the article, packing material and container.

Appellant's invention is shown in Figs. 2A, 2B, 3, and 4, line 22 of page 16 to line 17 of page 21. A copy of Fig. 2A appears next to this page.

The query at step **206** asks if a UPC bar code is available for the parcel to be shipped. If the response to the query is "YES," then the method advances to step **212** where the UPC value is compared to the UPC database to obtain an article postal or carrier weight, and the item volume and density, if found. Now the program goes to step **205** to buffer the current article weight with the other weight parameters and the current total weight. Then the program goes to decision block **203** to check if the total weight has been determined. If step **203** has not determined the total weight, the program goes to step **201** to read the next data field. If step **203** determines the total weight, the program goes to step **213** to determine if other parameters, i.e., density and volume, are present in the record. If step **213** determines no new parameters are present, the program goes to step **214**. If step **213** determines that new parameters are present, the program goes to step 350 (**FIG. 4**). Once the weight is obtained, the method advances directly to step **214**. However, if the response to the query at step **206** is "NO," then the method advances to the query at step **208**.

At step **208**, the method queries at to whether the article can be identified by a description of the article. If the response to the query is "YES," then the method advances to step **210** where the characteristics are input to the system, and the corresponding UPC data and the container weight are determined. From step **210**, the method flow advances to step **205**. If the response to the query at step **208** is "NO," then the method advances along path **A1** to step **230** as is shown in **FIG. 2B**.

Returning to step **214**, the method applies the article data, including the weight obtained at step **252**, to a rating engine to determine the rate to be charged for shipping the parcel via the selected carrier. The rate is returned at step **216** and applied to the article at step **218** by indicating the rate on a

corresponding carrier manifest, producing a label (which generally lists the addressee as well) corresponding to the rate, or both. In step **219**, the rate is applied for this container. The container is then prepared for shipping at step **220** and the routine for the parcel is concluded at step **222**.

Turning to **FIG. 2B**, there is shown the steps for returning a weight from the weights database. The flow begins with an input at step **230** from path **A1** coming from step **208** as is shown in **FIG. 2A**.

Step **230** is a query which asks if a manufacturer's name is present in the input data. If the response to the query is "YES," then the method advances to step **232** where a search of the database by manufacturer name is conducted. The method then advances to step **234** which queries as to whether or not the manufacturer's name is available. If the response to the query at step **234** is "NO," then the method advances to re-enter the flow at step **240**. If however, the response to the query at step **234** is "YES," then the method advances to the query at step **236** which asks if the manufacturer product number is available.

Returning to step **230**, if the response to the query is "NO," then the method advances to the query at step **240**. At step **240**, the system queries as to whether or not a product description is available. If the response to the query is "NO," then the method advances to step **245**. Step **245** requests that the user enter data the describes the product. Then the program advances to the query at step **246**. If, however, the response to the query at step **240** is "YES," then the program goes to step **242** to compare elements of the product description with elements in UPC database fields. Now the program advances to the query at step **244**.

Returning to step **236**, if the response to the query as to whether or not the product number is available is "NO," then the method advances to step **242** where the elements of the product are compared with elements in the UPC

database fields before advancing to the query at step **244**. If the response to the query at step **236** is "YES," then the system conducts a search of the database by the manufacturer's product number before advancing to the query at step **244**.

At step **244**, the system queries as to whether or not a match has been determined for the comparisons made of the manufacturer's name, product number, or description. If the response to the query is "NO," then the program advances to step **245** where the user is requested to enter the data. Then the program goes to step **246**. However, if the response to the query at step **244** is "YES," then the method advances directly to step **252** and returns a weight to the cost/rating routine for use at step **214**.

Turning to step **246**, the method queries as to whether or not the system user can enter (e.g., via keyboard entry or scanner entry) the weight directly to the routine. If the response to the query is "YES," then the data is entered into the entry fields of the routine at step **250**; otherwise, if the response to the query is "NO," then the program goes to step **247**. Step **247** sends to the user's display the following message: "Weight is not available. Take finished package to post/carrier for cost/rating." Then this routine goes to step **249** and then to step **222** to end. From step **250**, the method advances to step **252** where the weight is returned to the application in step **216** (**FIG. 2A**) for use in determining the cost/rate.

FIG. 3 is a drawing of a drawing of a view screen that will be displayed in the personal computer in user subsystem **10**, user station **170**, entry nodes **102**, **104**, **106**, **108**, and **110**. The data entry screen **300** is made up of seven subscreens indicated as **301**, **303**, **305**, **307**, **309**, **311**, and **313**. Each subscreen in turn contains one or more required data elements that the user must enter to define the article/mail piece for cost/rating, or to provide the needed data to allow computation of the container and its contents weight.

The first sub data entry screen **301** is in turn subdivided into four user data entry fields. They are identified as **A**, **B**, **C**, and **D** in **301**. Each field allows the user to identify the chosen carrier (**A**), the level of delivery service requested (**B**), any other requested services (**C**), and finally the destination information (**D**) that enables delivery.

The next data entry subscreen **303** provides a field (**E**) where the user could enter the actual final accurate shipping weight when it is already known to them. These circumstances are likely found in a manufacturer parcel-shipping site where standard boxes, packing and contents are combined in known arrangements.

The next three sub-screens (**305**, **307** and **309**) provide the numeric and text information that enables the present invention to operate. Subscreen **305** contains data entry lines labeled F1, F2 and more. Each line has fields for both the UPC code assigned to the contents item, as printed on its label, or found in its description. The "F" lines are filled in with either the UPC or a description until all the items are accounted for. The next subscreen **307** deals with the mail piece container. At least one "G" line must be selected, and either the UPC number entered or the description. The next subscreen **309** deals with the packing and tape used to form the mail piece/container. At least one "H" line must be selected, and both the UPC number entered and a description of what was consumed.

Sub-screens **311** and **313** are not for data entry. These subscreens inform the user about the status of the "mail-ability" in ("I") of the mail piece, and the current cost in (J).

FIG. 4 is a flow chart of the process for determining the cost of the other materials used to complete the container. The program begins in step **350** when step **213** (**FIG. 2A**) detects other parameters.

Step **350** reads the input records from sub-screens **310-309** (**FIG. 3**). Then the program goes to decision step **352**. Step **352** determines whether or not other parameter data entries are present in the data record. If other parameters are not present, the program goes to step **214** (**FIG. 2A**). If other parameters are present in step **352**, the program goes to step **354** to read or compute values for the current postal weight; container volume; sum of the contents items and packing material density. In step **356**, the program subtracts all contents volumes found from the container volume. Then, in step **358** the program multiplies the computed volume difference by the given packing material density. In step **360**, the program adds the computed postal weight for the packing used to the current postal weight. In step **362**, the file is returned to step **214** (**FIG. 2A**)

Claim 5 is the second of the two independent claims in this patent application that is on appeal. Claim 5 is a method for providing for weight-based determinations of one or more articles to be shipped. Claim 5 includes the following steps: a) initiating a cost determining routine in a shipping system application at a first node;

b) entering a code or a description of each one of said one or more articles into a first data field of said routine;

c) entering a code or a description of the container in which the articles are going to be shipped;

d) transmitting a query from said routine to a database located at a second node for a weight associated with said each one of said one or more articles and said container;

e) returning said weight to said routine for use in calculating a cost for shipping said each of said one or more articles and said container;

f) entering said weight into a second data field of said shipping system application as an input parameter; and

g) determining said cost for shipping said each of said one or more articles and container based upon a set of one or more input parameters.

Appellant's invention is shown in Figs. 2A, 2B, 3, and 4, line 22 of page 16 to line 17 of page 21, which was set forth above.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether or not claims 3 and 5-17 are patentable under 35 U.S.C. §103(a) over Nicholls, et al. (U.S. Patent No. 5,485,369) in view of Godin, et al., (U.S. Patent No. 5,890,138).

VIII. ARGUMENTS

Claims 3 and 5-17 have been rejected by the Examiner under 35 U.S.C. §103(a) over Nicholls, et al. (U.S. Patent No. 5,485,369) in view of Godin, et al., (U.S. Patent No. 5,890,138).

A. Claims 3, 15 and 17.

Nicholls et al discloses the following in line 58 of col. 3 to line 7 of col.4.

"The order packaging station may also comprise one or more computer terminals to which a bar code scanning device 28 may be optionally attached. The scanning device would be used, for example, to scan the Universal Product Code (UPC) of each item as it is picked from the warehouse shelves and placed into the shipping container 30.

The shipping station 26 similarly may include one or more computer terminals to which a scanning device 32, electronic scale 34 and mailing label printers 36 may be attached. Preferably, the printers are capable of printing the necessary shipping documents,

bills of lading, manifests and so forth, as well as the appropriate package labeling. If desired in the alternative, the package label may be preprinted (e.g. at the packing station) and the scanning device 32 may be used to read the label and thereby automatically enter the package identifying number into the system."

Nicholls is using a UPC code to identify a package and to give the package a name and number so that the package identifying number may be automatically entered into the system.

Godin discloses the following in lines 21-41 of column 3:

"There are several aspects which have to be addressed to maintain security of information maintained in the database server 22 as well as the banking system shown as 28. A firewall 20 prevents any user 8 from accessing any of the components behind the firewall 20. In this way the users have access to the web server computers 10 and 12, but only have access to the database server through the firewall 20. The database server maintains, amongst other things, various database fields with respect to each of the products which are slated to be auctioned. As shown in FIG. 4, these data fields include a UPC code, a product description, an auction date and time, a current quantity, a starting price for the auction, a closing price for the auction, a large product image, a small product image, product carry, warranty cost, a minimum cost, a designation whether a warranty is available, an auction end time, a product catalogue, a product weight which is used as part of the shipping costs, an extended product description, a product street price, a product vendor allocation as well as an auction produce number."

Godin discloses a product weight as part of the shipping cost but does not disclose anything about the packing material and container.

Godin discloses the following in column 3, lines 31-41:

“As shown in **FIG. 4**, these data fields include a UPC code, a product description, an auction date and time, a current quantity, a starting price for the auction, a closing price for the auction, a large product image, a small product image, product carry, warranty cost, a minimum cost, a designation whether a warranty is available, an auction end time, a product catalogue, a product weight which is used as part of the shipping costs, an extended product description, a product street price, a product vendor allocation as well as an auction product number.”

Godin discloses a reverse auction system in which the weight of the product is a part of the shipping cost. Godin does not disclose how to determine the weight of the package and, therefore, the cost of mailing the package.

Neither Nicholls nor Godin, taken separately or together, discloses or anticipates the system and method claimed by Appellant in claims 3-17, namely, a system and method of returning a weight from a weight field of a database wherein said database has at least one data field for storing a set of data relative to a corresponding article, packing material, and container, and wherein said set of data comprises at least said weight field.

For instance, the cited art does not disclose steps (c), (d), and (e) of claim 3, which read as follows:

- (c) transmitting a query from said routine to said database for a weight associated with said corresponding article, said packing material, and said container;
- (d) returning said weight to said routine; and
- (e) displaying the cost to ship the article, packing material and container.

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

B. Claims 5 – 9 and 12 – 14

Nicholls et al discloses the following in line 58 of col. 3 to line 7 of col.4.
“The order packaging station may also comprise one or more computer terminals to which a bar code scanning device 28 may be optionally attached. The scanning device would be used, for example, to scan the universal product code (UPC) of each item as

it is picked from the warehouse shelves and placed into the shipping container 30.

The shipping station 26 similarly may include one or more computer terminals to which a scanning device 32, electronic scale 34 and mailing label printers 36 may be attached. Preferably, the printers are capable of printing the necessary shipping documents, bills of lading, manifests and so forth, as well as the appropriate package labeling. If desired in the alternative, the package label may be preprinted (e.g. at the packing station) and the scanning device 32 may be used to read the label and thereby automatically enter the package identifying number into the system."

Nicholls is using a UPC code to identify a package and to give the package a name and number so that the package identifying number may be automatically entered into the system.

Godin discloses the following in lines 21-41 of column 3:

"There are several aspects which have to be addressed to maintain security of information maintained in the database server 22 as well as the banking system shown as 28. A firewall 20 prevents any user 8 from accessing any of the components behind the firewall 20. In this way the users have access to the web server computers 10 and 12, but only have access to the database server through the firewall 20. The database server maintains, amongst other things, various database fields with respect to each of the products which are slated to be auctioned. As shown in FIG. 4, these data fields include a UPC code, a product description, an auction date and time, a current quantity, a starting price for the auction, a closing price for

the auction, a large product image, a small product image, product carry, warranty cost, a minimum cost, a designation whether a warranty is available, an auction end time, a product catalogue, a product weight which is used as part of the shipping costs, an extended product description, a product street price, a product vendor allocation as well as an auction produce number.”

Godin discloses a product weight as part of the shipping cost but does not disclose anything about the packing material and container.

Godin discloses the following in column 3, lines 31-41:

“As shown in **FIG. 4**, these data fields include a UPC code, a product description, an auction date and time, a current quantity, a starting price for the auction, a closing price for the auction, a large product image, a small product image, product carry, warranty cost, a minimum cost, a designation whether a warranty is available, an auction end time, a product catalogue, a product weight which is used as part of the shipping costs, an extended product description, a product street price, a product vendor allocation as well as an auction product number.”

Godin discloses a reverse auction system in which the weight of the product is a part of the shipping cost. Godin does not disclose how to determine the weight of the package and, therefore, the cost of mailing the package.

For instance the cited art does not disclose steps d, e, f and g of claim 5, which read as follows:

d) transmitting a query from said routine to a database located at a second node for a weight associated with said each one of said one or more articles and said container;

- e) returning said weight to said routine for use in calculating a cost for shipping said each of said one or more articles and said container;
- f) entering said weight into a second data field of said shipping system application as an input parameter; and
- g) determining said cost for shipping said each of said one or more articles and container based upon a set of one or more input parameters.

Furthermore, the cited art does not disclose or anticipate the query disclosed by Appellant in:

Line 12 – line 19 of Page 20 of Appppellant's specification read as follows:

"The next three subscreens (**305**, **307** and **309**) provide the numeric and text information that enables the present invention to operate. Subscreen **305** contains data entry lines labeled F1, F2 and more. Each line has fields for both the UPC code assigned to the contents item, as printed on its label, or found in its description. The "F" lines are filled in with either the UPC or a description until all the items are accounted for. The next subscreen **307** deals with the mail piece container. At least one "G" line must be selected, and either the UPC number entered or the description. The next subscreen **309** deals with the packing and tape used to form the mail piece/container. At least one "H" line must be selected, and both the UPC number entered and a description of what was consumed."

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to

arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

C. Claim 10

Claim 9 is dependent on claim 5 and claim 10 is dependent on claim 9.

Claim 9 has the following step added to the method claimed in claim 5, wherein said database further comprises a set of data comprising a recorded weight associated with a set of one or more articles wherein said recorded weight is entered by a system operator.

Claim 10 has the following steps added to the method claimed in claim 9, entering a code or a description of the packing material that is included in the container to be shipped; and determining the cost for shipping the packing material.

In addition to the arguments made in above Section B, please consider the following.

The Examiner has not cited any art in the context of the claimed invention that shows that it would be obvious to: enter a code or a description of the packing material that is included in the container to be shipped; and determining the cost for shipping the packing material.

D. Claim 11

Claim 11 is dependent on claim 10.

Claim 11 has the following step added to the method claimed in claim 10, determining the weight of the packing material using the volume of the container minus the volumes of the articles in the container multiplied by the density of the packing material.

In addition to the arguments made in above Sections B and C, please consider the following.

The Examiner has not cited any art in the context of the claimed invention that shows that it would be obvious to: determine the weight of the packing material using the volume of the container minus the volumes of the articles in the container multiplied by the density of the packing material.

E. Claim 16

Claim 16 is dependent on claim 13 and claim 13 is dependent on claim 5.

Claim 13 has the following step added to claim 5, isolating the containers that do not have the proper postage.

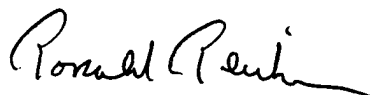
Claim 16 has the following steps added to the method claimed in claim 13, comparing the stored weight for shipping the article and container in the completed container database with the weight determined by the carrier to ship the container; and querying the manufacturer of the articles and containers concerning their actual weight if the compared total weights are not the same.

In addition to the arguments made in above Section B, please consider the following.

The Examiner has not cited any art in the context of the claimed invention that shows that it would be obvious to: isolate the containers that do not have the proper postage, comparing the stored weight for shipping the article and container in the completed container database with the weight determined by the carrier to ship the container; and querying the manufacturer of the articles and containers concerning their actual weight if the compared total weights are not the same.

In view of the above Appellants respectfully submit that appealed claims 3 and 5 – 17 in this application are patentable. It is requested that the Board of Appeal overrule the Examiner and direct allowance of the rejected claims.

Respectfully submitted,



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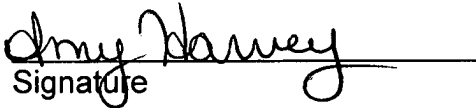
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Date of Deposit

Amy Harvey
Name of Rep.


Signature

January 11, 2005
Date

VIII.. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

3. A method of returning a weight from a weight field of a database wherein said database has at least one data field for storing a set of data relative to a corresponding article, packing material, and container, and wherein said set of data comprises at least said weight field, the method comprising the steps of:

- (a) initiating a cost determining routine in a shipping system application at a first node;
- (b) entering a description of said corresponding article, said packing material, and said container into a first data field of said rate determining routine;
- (c) transmitting a query from said routine to said database for a weight associated with said corresponding article, said packing material, and said container;
- (d) returning said weight to said routine; and
- (e) displaying the cost to ship the article, packing material and container.

(d) second data entry means for entering said weight into a second data field of said shipping system application as an input parameter; and

(e) calculating means within said cost determining means for calculating said cost for shipping said article, said packing material, and said container to said particular destination based upon a set of one or more input parameters.

5. A method of providing for weight-based determinations of one or more articles to be shipped, the method comprising the steps of:

- a) initiating a cost determining routine in a shipping system application at a first node;
- b) entering a code or a description of each one of said one or more articles into a first data field of said routine;

c) entering a code or a description of the container in which the articles are going to be shipped;

d) transmitting a query from said routine to a database located at a second node for a weight associated with said each one of said one or more articles and said container;

e) returning said weight to said routine for use in calculating a cost for shipping said each of said one or more articles and said container;

f) entering said weight into a second data field of said shipping system application as an input parameter; and

g) determining said cost for shipping said each of said one or more articles and container based upon a set of one or more input parameters.

6. The method of claim 5, wherein said initiation of said routine is via Internet or modem and where said initiating site is remote to said database.

7. The method of claim 5 wherein said initiation of said routine occurs at a data processing system co-located with said application and said database.

8. The method of claim 5, wherein said database further comprises a set of codes (such as UPC or EAN) data.

9. The method of claim 5, wherein said database further comprises a set of data comprising a recorded weight associated with a set of one or more articles wherein said recorded weight is entered by a system operator.

10. The method of claim 5, further including the steps of:
entering a code or a description of the packing material that is included in the container to be shipped; and
determining the cost for shipping the packing material.

11. The method claimed in claim 10, further including the steps of determining the weight of the packing material using the volume of the container minus the volumes of the articles in the container multiplied by the density of the packing material.
12. The method of claim 5, further including the steps of:
 - storing the cost for shipping each one or more articles and the container in a completed container data base at the second node;
 - submitting said container to a carrier for acceptance; and
 - determining by the carrier the cost to ship said container.
13. The method of claim 12, further including the step of:
 - isolating the containers that do not have the proper postage.
14. The method of claim 13, further including the step of:
 - billing mailers who have not paid sufficient funds to ship said container.
15. The method of claim 13, further including the step of:
 - refunding monies to mailers who have overpaid to ship said container.
16. The method claimed in claim 13, further including the steps of:
 - comparing the stored weight for shipping the article and container in the completed container database with the weight determined by the carrier to ship the container; and
 - querying the manufacturer of the articles and containers concerning their actual weight if the compared total weights are not the same.
17. The method claimed in claim 16, further including the step of:
 - updating the weights associated with each one or more articles and said container at the database located at the second node.

IX. EVIDENCE APPENDIX

There is no additional evidence to submit.

IX. RELATED PROCEEDING APPENDIX

There are no related appeals and interferences.